APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/614,584	07/07/2003	Frank Gordon Krausz	10547.26US2	7595

34018   7590   12/22/2008
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ART UNIT	PAPER NUMBER
2178	

MAIL DATE	DELIVERY MODE
12/22/2008	PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRANK GORDON KRAUSZ and JOHN RUARK

Appeal 2008-2061
Application 10/614,584[1]
Technology Center 2100

Decided: December 19, 2008

Before: JOSEPH L. DIXON, JAY P. LUCAS, and ST. JOHN
COURTENAY III, *Administrative Patent Judges*.

LUCAS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

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[1] Application filed July 7, 2003. Appellants claim the benefit under
35 U.S.C. § 119 of provisional application 60/394,984, filed 07/10/2002.
The real party in interest is Comverse, Inc.

Appellants appeal from a final rejection of claims 14 to 22 under authority of 35 U.S.C. § 134. The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b).

Appellant's invention relates to a method for generating documents, specifically invoices, in an automated and efficient manner. In the words of the Appellants:

> In accordance with these and other needs, a system and method for generating invoices using a markup language is hereinafter described. In accordance with this system and method, the specification of a invoice layout may be created by a graphical user interface "GUI" application. The invoice layout specification may then be used by an background business-process application to create actual invoices populated with customer data as well as data common to all customers (e.g., using standard formats for currencies, descriptions of the client's service options, etc.). This layout specification may then be stored in a subset of the XML standard referred to hereinafter as the "Invoice Markup Language" or "IML."

> (Spec., page 3)

Claim 14 is exemplary:

> 14. A method for generating an invoice comprising:
>
> using a graphical user interface tool to create an IML file including a first set of IML tags defined by a document type definition that are used to select data from inclusion in the invoice and a second set of IML tags defined by the document type definition that are used to specify both a page style for the invoice and how the selected data is to be displayed within the invoice;
>
> providing the IML file to an invoice generating application which accesses a database of a service provider to collect data according to the firs set of tags and which uses the collected data and the second set of tags to generate an invoice output file; and

providing the invoice output file to an output device which uses the invoice output file to generate the invoice.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Emmett	US 2002/0129006 A1	Sep. 12, 2002
Scolini	US 2003/0233321 A1	Dec. 18, 2003
Viswanath	US 2003/0074271 A1	Apr. 17, 2003
Matsakis	US 2005/0273772 A1	Dec. 8, 2005

Peat, Introducing XML/EDI . . . "the e-Business framework", August 1997, pages 1-19.

REJECTIONS

R1: Claims 14 to 16, 18, and 20 to 21 stand rejected under 35 U.S.C. 103(a) for being obvious over Viswanath in view of Matsakis and Peat.

R2: Claim 17 stands rejected under 35 U.S.C. 103(a) for being obvious over Viswanath, Matsakis and Peat in view of Emmett.

R3: Claims 19 and 22 stand rejected under 35 U.S.C. 103(a) for being obvious over Viswanath, Matsakis and Peat in view of Scolini.

Groups of Claims:

As Appellants' arguments are directed primarily at Viswanath, and therefore applicable to all rejections, the rejections R1, R2, and R3 will be considered together.

Appellants contend that the claimed subject matter is not rendered obvious by Viswanath alone, or in combination with Matsakis and Peat, for

failure of the references to teach key limitations in the claims. The Examiner contends that each of the claims is properly rejected.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellants have been considered in this opinion. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived.

We affirm the rejections.

ISSUE

The issue is whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 103(a). The issue turns on whether Viswanath in combination with the other references teaches the method of creating a single XML file with tags that are so defined as to both select data for inclusion in the resultant document (invoice) and to specify the page style and data placement in the resultant document, as claimed.

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Appellants have invented a method of generating invoices using a subset of the standard eXtensible Markup Language (XML) called IML. IML is sometimes in the specification referred to as "Invoice Markup Language" (Spec., p. 3, ll. 8-9) or "Internet Markup Language" (Spec., p 15, l. 1), but consistently is treated as a directed purpose XML file that generates

invoice files. (Spec., p. 8, l. 18). The IML file is created using standard graphical user interface (GUI) tools, admitted to be well known in the art. (Spec., p. 8, ll. 21-22). A key aspect is that the IML file created by the GUI accesses content data from relevant databases and also accesses page layout data to specify how the information is displayed. (Spec., p. 3, ll. 1 to 9). The resultant invoice may be rendered in Hyper Text Markup Language (HTML) for display on a standard web browser, or in XML for transmission. (Spec., p. 3, ll. 12-15).

2. The reference Viswanath is a Patent Application Publication disclosing a system to generate documents, specifically a purchase order #540. (¶ 73) The purchase order authorizes the purchase of supplies from a Supplier #330 as needed by user #310. (See Fig. 3). The system is based on a subset of XML called the OBI standard (Open Buying on the Internet) which is used by many suppliers for on-line selling. (¶ 17). The Buyer Organization #320 maintains databases, such as databases #140 and #150, which contains details of the suppliers catalogs, information on the suppliers, orders from the users, information about the users, and other specific data. (¶ 46 and ¶ 47). Viswanath's system creates out-going documents, such as purchase orders #540, by having tags in the OBI-XML document (¶ 77) that retrieve objects from database #140 to populate the purchase order. (¶ 84 and ¶ 85). The XML data source also retrieves data objects to transform the purchase order into HTML format (¶ 24), by which language the purchase order is properly displayed.

PRINCIPLES OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. See *In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

"What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under *§ 103*." *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742 (2007). To be nonobvious, an improvement must be "more than the predictable use of prior art elements according to their established functions." *Id.* at 1740

"It is common sense that familiar items may have obvious uses beyond their primary purposes, and a person of ordinary skill often will be able to fit the teachings of multiple patents together like pieces of a puzzle." *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1732 (2007).

"A court must ask whether the improvement is more than the predictable use of prior-art elements according to their established functions." *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1731 (2007).

ANALYSIS

From our review of the administrative record, we find that the
Examiner has presented a prima facie case for the rejections of Appellants'
claims under 35 U.S.C. § 103. The prima facie case is presented on pages 3
to 8 of the Examiner's Answer. In opposition, Appellants present a number
arguments.

Arguments with respect to the rejections
R1, R2, and R3 of claims 14 to 22
under 35 U.S.C. § 103

Appellants first contend that the Examiner erred in rejecting claims 14
to 22 under 35 U.S.C. 103(a) by failing to disclose in the references the use
of a GUI to create a file that both selects data for inclusion in a document
and that specifies a page style and how to display the selected data within
the document. (Br., p. 5, bottom). More specifically, Appellants contend
that Viswanath does disclose using a GUI for "allowing an existing
electronic catalog to be mapped to the e-procurement system disclosed
within Viswanath… [b]ut does not disclose, teach or suggest using the
graphical user interface tool for any other purpose." (Br., p. 6, top).

> "More importantly, Viswanath never discloses, teaches or suggests
> using the graphical user interface tool to create a file that includes
> both a first set of tags defined by a document type definition that are
> used *to select data* for inclusion in a document, particularly a purchase
> order as allege in the rejection of the claims, *and* a second set of tags
> defined by the document type definition that are used to specify *both a*
> *page style for the document and how to display the selected data*
> *within the document.*"

(Br., p. 6, middle).

The Viswanath reference has a number of teachings which are brought to bear and to create the output documents, which include the purchase order #540 of the system. (See FF #2, above). We note that the secondary references equate Viswanath's creation of a purchase order to the claimed creation of an invoice. (Ex. Ans., p. 5, bottom). Firstly, the use of a GUI to manipulate the XML files is considered standard practice in the art, as admitted by the Appellants (Spec., p. 8, l. 21 to 23) and as used in at least two places in Viswanath (¶ 51 and ¶ 60). Next, the use of tags within an XML document to retrieve data for the output document is clearly taught by the Viswanath reference. (¶ 76 teaches retrieving address and billing data for the invoice using the XML tags, for example. Further, the retrieval process retrieves data from database #140, as disclosed in ¶ 85). Viswanath teaches the XDOC processor #220 generates the purchase order by examining the tags of the XML incoming document and causing the retrieval of the data from the databases. (¶ 54) to populate the purchase order document. (¶ 55). Finally, Viswanath teaches the transformation of the XML data to "an appropriate format such as a Hyper-Text Markup Language and a host of other markup languages." HTML by its nature specifies page styles and how the data will be display, in the same manner as disclosed by the Appellants (Spec. page 9, ll. 8 to 12) and as claimed.

Appellants argue further that Viswanath does not teach the same file retrieving the data and specifying the layout of the purchase order. (Br., p. 8, top). In XML and HTML, the layout of a document is specified by a style sheet referenced in a document type definition, DTD. The content is specified by the XML coding in the DTD itself. As both the instant

invention and the reference specify an HTML output document, the claims are rendered an obvious implementation of the teachings in the reference Viswanath, in which the XML document evokes the retrieval of the data, and then its display.

The use of the supplemental references Matsakis and Peat, and Emmett and Scolini have not been argued except to say that they do not cure the alleged deficiencies in Viswanath. (Br., p. 9, top and middle). As we do not concur with a finding of such a deficiency, we decline to find error in the Examiner's rejection.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner did not err in rejecting claims 14 to 22.

DECISION

R1: The rejection of claims 14 to 16, 18 and 20 to 21 under 35 U.S.C. 103(a) for being obvious over Viswanath in view of Matsakis and Peat is affirmed.

R2: The rejection of claim 17 under 35 U.S.C. 103(a) for being obvious over Viswanath, Matsakis and Peat in view of Emmett is affirmed.

R3: The rejection of claims 19 and 22 under 35 U.S.C. 103(a) for being obvious over Viswanath, Matsakis and Peat in view of Scolini is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

<u>AFFIRMED</u>

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